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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,711	08/23/2001	Arthur A. Renda	10011961-1	1781

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EXAMINER	
DIVINE, LUCAS	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,711

Applicant(s)

RENDA, ARTHUR A.

Examiner

Lucas Divine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 20, 22 and 23 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Claims 19 – 23 are pending.

Response to Arguments

2. The indicated allowability of claims 19, 20, 22, and 23 is withdrawn in view of the newly discovered reference(s) to Chan et al. (US 6378070). Rejections based on the newly cited reference(s) follow. Accordingly, to give applicant's adequate time to respond, this action is **non-final** and finality of previous Action is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 19, 20, 22, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan.

Regarding claim 19, Chan teaches a method, comprising:

retrieving data from a file in a memory of the PC Card (recipients data is read from the card by the reader, e.g. 405 – col. 7 line 2) that is in an AV predetermined format (the card

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supports ISO 7816 format) **with a PC Card reader integrated in a printing device** (143 in 140, col. 4 lines 55-59);

assembling a key from the retrieved data (step 420, CPU generating a message including the retrieved identity information);

downloading information identified by the key (485, downloading the documents from the document store, the documents being identified by the identity of the user; col. 3 lines 49-50, 56); and

printing a report utilizing the downloaded information (495), wherein after said **retrieving said printing is capable of occurring without a user intervention** (no steps, including printing, of Fig. 4 must occur with user intervention, thus occurring without, col. 5 line 7).

Regarding the ISO 7816 format that that card is in, Chan teaches that the card is in this format, but does not specifically teach the format is an AV format. The format is the standard smart card format and Iwasaki (6651149) teaches that the smart card format supports music data, which is AV data (e.g. col. 8 lines 8-10). Thus, Iwasaki shows the inherency of the smart card of Chan being in an AV format.

Regarding claim 20, which depends from claim 19, Chan teaches **downloading information further comprises accessing a remote site and determining if the key is matched at the remote site in order to the download the information** (e.g. col. 2 lines 27-32, col. 7 lines 8-10).

Regarding claim 22, which depends from claim 19, Chan teaches **downloading information further comprises accessing a universal resource locator (URL) in the key and**

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utilizing the URL to locate and download the information (in order to correctly execute step 425, the URL of the server must be in the message to route the message correctly over the network to the DST).

Regarding claim 23, Chan teaches the actions are completed by computing devices, thus based on internal code (e.g. CPU and ROM/DRAM shown in Fig. 2). Thus, claim 23 is rejected for the reasons set forth in the rejection to claim 19.

Allowable Subject Matter

4. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'KYP', is positioned above the printed name of the examiner.

Lucas Divine
Examiner
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ljd

**KING Y. POON
PRIMARY EXAMINER**